

PATENT APPLICATION
Docket No. 16096.6

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Khemani, et al.

Serial No.: 10/087,718

Filed: March 1, 2002

Conf. No.: 7476

For: BIODEGRADABLE FILMS AND SHEETS
SUITABLE FOR USE AS COATINGS, WRAPS
AND PACKAGING

Examiner: Ana L. Woodward

Customer No.: 022913

DECLARATION OF SIMON K. HODSON

UNDER 37 C.F.R. § 1.131

Mail Stop AMENDMENT
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

I, Simon K. Hodson, hereby declare as follows:

1. I am one of the co-inventors of the subject matter disclosed and claimed in the above-identified application (“Subject Application”), and I am personally knowledgeable of the facts stated herein.

2. Kishan Khemani and Harald Schmidt are the other co-inventors of the subject matter disclosed and claimed in the Subject Application.

3. The subject matter claimed in the Subject Application is the result of a joint effort between me, Mr. Khemani and Mr. Schmidt.

4. The Subject Application is assigned to bio-tec Biologische Naturverpackungen GmbH & Co., KG. ("Biotec"), which is located at Werner-Heinsenbergr. 32, Emmerich, Germany 46446.

5. Mr. Khemani and myself were employees of E. Khashoggi Industries, LLC ("EKI"), and Mr. Schmidt was an employee of Biotec, at the time of the invention.

6. The concept of biodegradable food wraps comprising one or more biodegradable polymers and an inorganic particulate filler, particularly an embodiment comprising a blend of Biomax and Ecoflex polymers and inorganic particulate fillers, was conceived at least as early as July 2, 2000, as evidenced by a copy of an electronic mail communication attached hereto as Exhibit A from Mr. Khemani to me ("July 2, 2000 e-mail").

7. A patent application was filed soon thereafter on August 23, 2000 as U.S. application Serial No. 09/648,471 ("471 Application), covering a blend of biodegradable polymers and fillers, as well as biodegradable sheets and films, suitable for use in making food wraps that are similar or identical to blends and wraps disclosed and claimed in the Subject Application.

8. The '471 Application issued as U.S. Patent No. 6,573,340 ("340 Patent") on June 3, 2003 and currently names the same inventors as the Subject Application, as indicated by a Certificate of Correction issued by the USPTO on November 11, 2003. A copy of the '340 patent (including the Certificate of Correction) is attached hereto as Exhibit B.

9. Both the '471 Application and the Subject Application were initially assigned to EKI when initially filed, and both were thereafter re-assigned at the same time to Biotec.

10. Although the Subject Application does not claim priority to the '471 Application, the subject matter disclosed in the '340 Patent is evidence of the invention date of the subject matter disclosed and claimed in the Subject Application since the inventors of the '340 patent and the Subject Application are the same.

11. After the July 2, 2000 e-mail, we (the inventors) worked diligently to prepare and test various biodegradable polymer and filler blends on an ongoing basis to determine which worked best as a food wrap for their intended purpose, as evidenced by the filing of the '471 Application, which included working examples evidencing an actual reduction to practice of blends used to manufacture wraps and which constituted a constructive reduction to practice of whatever else is disclosed therein, as well as a series of electronic communications dated

between February 25, 2001 and October 16, 2001, copies of which are attached hereto as Exhibits C-G.

12. In an e-mail dated February 25, 2001 (Exh. C), reference is made to “paper-like tissue, 30 micron”, which refers to polymer films that were made as of that time that included particulate fillers and that were stretched during processing (*i.e.*, “blowing”) and/or that had filler particles that protruded from the surface of the film in order to create a roughened and/or porous surface that gave the film the look and feel of paper-like tissue.

13. An e-mail dated April 6, 2001 (Exh. D) includes extensive economic modeling of the wrap technology, which further evidences the amount of work (*i.e.*, diligence) that was being performed on an ongoing basis to create a market for the wraps.

14. An e-mail dated June 22, 2001 (Exh. E) discusses “previous wrap trials” that were performed on actual filled polymer sheets, which is further evidence of the extent to which the wrap technology had been developed and tested.

15. An e-mail dated September 25, 2001 (Exh. F) provides extensive test results relating to microwaveability, grease resistance, burger test, puncture resistance, dead fold, and time in motion. Among other things, this communication shows that, although the polymer films breathed less than paper wraps, they did breath nevertheless, indicating that they included significant cavitation as a result of stretching. In addition, the films exhibited dead fold of 100%.

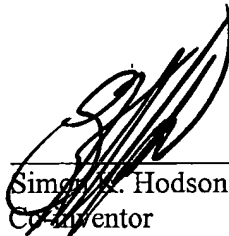
16. An e-mail dated October 16, 2001 (Exh. G) refers to a filled polymer film wrap that included 35% filler.

17. Within a few months, the Subject Application was drafted and then it was filed on March 1, 2002.

18. As at least partially evidenced by the documentary evidence attached hereto, I declare that the subject matter of at least claims 1-13 and 15-35 was invented prior to December 7, 2000.

I declare further that all statements made herein of my own knowledge are true and that all statements are made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful, false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful, false statements may jeopardize the validity of the application or any patent issuing thereon.

Signed at Santa Barbara, California, this 10th day of October, 2005.



Simon K. Hodson
Co-Inventor

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